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PHILADELPHIA, PA 19102

EXAMINER

NGUYEN, CHAU T

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2176

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 12

Application Number: 09/383,857

Filing Date: August 26, 1999

Appellant(s): STAHL, DAVID R.

Steven R. Petersen
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on July 14, 2003.

(1) Real Party in Interest

The appellant's statement of the real party in interest contained in the brief is correct.

(2) Related Appeals and Interferences

The appellants' statement of the related appeals and interferences contained in the brief is correct.

(3) Status of Claims

The appellants' statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellants' statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellants' statement of the issues contained in the brief is correct.

(7) Grouping of Claims

The appellants' statement of the grouping of the claims in the brief is correct.

(8) Claims Appealed

The copy of the appealed claims contained in the appendix pages 13-15 is correct.

(9) Prior Art of Record

Gile et al., U.S. Patent Number 6,317,779 B1, issued on November 13, 2001, but filed on September 3, 1998 (hereinafter Gile).

Gardell et al., U.S. Patent Number 6,049,831, issued on April 11, 2000, but filed on February 13, 1997 (hereinafter Gardell).

(10) New Prior Art

No new prior art has been applied in this examiner's answer.

(11) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims 1-6, 8-18, and 20-24:

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Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gile et al., Patent No. 6,317,779 and further in view of Gardell et al., Patent No. 6,049,831.

As to claim 1, Gile discloses a method for providing information over a computer network, comprising the steps of:

- (a) providing for a user profile, wherein the user profile defines a schedule of two or more information requests (Abstract, col. 3, lines 10-27: user customized profile (selected services, order, and desired ready time); a user selects a number and order of available services desired such as the evening news, stock quotes, and entertainment news);
- (b) preparing a set of information corresponding to each information request (Abstract, col. 3, lines 10-27); and
- (c) automatically delivering each set of information at a time based on the schedule (Abstract, col. 3, lines 10-27).

However, Gile does not explicitly disclose requested network information having a corresponding destination, including a first information request having a corresponding first destination and a second information request having a corresponding second destination different from the first destination. In the same field of endeavor, Gardell discloses a user accesses a network from several devices (computer, television, etc...) to request for network information (Abstract, col. 6, line 50

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– col. 8, line 19). Fig. 7 also shows one path from STB (Set Top Box) 752 sending requests for Web page to Web browser servers 730, and another path from computer 746 accessing the Internet in the traditional way. Since Gardell teaches a method for retrieving web pages to different user devices, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated requesting network information to different devices in a system for transmitting network-related information as taught by Gardell into a system and method for allowing a user to select and download audio/visual tracks from the Internet of Gile because it would allow more flexible ways of accessing networks, particularly the Web.

As to claim 2, Gile and Gardell (Gile-Gardell) disclose the corresponding destination for a particular information request is an Internet radio and the corresponding set of information has an audio format for rendering on the Internet radio (Gardell, col. 5, lines 17-25 and col. 6, lines 50-64:STB 752 (Set Top Box) and television 758 access the Internet for service information, and Internet server 714 transmit service information to the STB. Also, the service information would be recomposed according to the particular audio-visual requirements of the attached device).

As to claim 3, Gile-Gardell disclose the corresponding destination for a particular information request is an Internet television and the corresponding set of information

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has an audio/video format for rendering on the Internet television (Gardell, col. 5, lines 17-25 and col. 6, lines 50-64).

As to claim 4, Gile-Gardell disclose the corresponding destination for a particular information request is a personal computer and the corresponding set of information has at least one of an audio, a video, and a text format for rendering on the personal computer (Gile, Abstract, and col. 3, lines 10-27; Gardell, col. 5, lines 17-25 and col. 6, lines 50-64).

As to claim 5, Gile-Gardell disclose step (a) further comprises the step of presenting a computer-based interface for a user to define the user profile (Gile, col. 1, lines 43-50 and col. 2, lines 32-41)

As to claim 6, Gile-Gardell disclose step (c) further comprises the step of initiating a connection to the corresponding destination over the computer network at the time based on the schedule (Gile, col. 2, line 10 – col. 3, line 27).

As to claim 8, Gile-Gardell disclose each of the first and second destinations is an Internet radio, and Internet television, or a personal computer (Gardell, Abstract, and col. 6, line 50 – col. 8, line 19).

As to claim 9, Gile-Gardell disclose the sets of information for the first and second information requests are automatically delivered to the corresponding first and second destinations at different times based on the schedule (Gile, col. 1, lines 53-64, col. 3, lines 10-31, and col. 3, lines 4-27).

As to claim 10, Gile-Gardell disclose step (b) further comprises the step of converting format of the set of information based on the corresponding destination (Gardell, col. 4, lines 9-54).

As to claim 11, Gile-Gardell disclose step (b) further comprises the step of gathering the set of information from two or more different network-based sources of information (Gardell, col. 6, lines 16-49, and Fig. 6).

As to claim 12, Gile-Gardell disclose the step of providing a user with flexibility to modify the information requests or the corresponding destination or the schedule (Gile, col. 2, line 32 – col. 3, line 53).

Claims 13-18 and 20-24 are corresponding apparatus claims containing the similar limitations as the method described in the claims 1-6, and 8-12; therefore, they are rejected under the same rationale.

(12) Response to Argument

The examiner summarizes the various points raised by the appellant and addresses replies individually.

As per appellants' arguments filed on July 14, 2003, the appellants argue in substance:

A. Procedural Background

"Applicant argued that it would not have been obvious to modify Gile in the manner that would be necessary in order to form the claimed invention, because such modification would be antithetical to the purposes of the Gile system. Applicant also argued that Gardell cannot fairly be read as disclosing the features of the invention that are omitted in Gile." (See brief, pages 3-4)

In reply to argument in group A (Procedural Background), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21

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USPQ2d 1941 (Fed. Cir. 1992). Also, *In re Mclaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCP 1971), clearly states “any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within level of ordinary skill at the time claimed invention was made and does not include knowledge gleaned only from applicants’ disclosure, reconstruction is proper”. In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In this case, Gile discloses in Abstract and col. 3, lines 10-27: user customized profile (selected services, order, and desired ready time); a user selects a number and order of available services desired such as the evening news, stock quotes, entertainment news, and selects a desired time for these data to be downloaded to the user’s device base based on the user customized profile.

Gile specifically discloses in col. 5, line 65 – col. 6, line 5 that various changes and modifications could be made without departing from the invention, therefore the invention is not limited to one device receiving data across the Internet. However, Gile does not explicitly disclose requesting network information to different devices.

In the same field of endeavor, Gardell acknowledges that different types of content web page retrieved or downloaded to one device are inefficient (col. 1, lines 22-57). Therefore, Gardell provides requested network information is downloaded to several devices (computer, television, etc...) (Abstract, col. 6, line 50 – col. 8, line 19). An artisan working with Gile would be motivated to look for downloading or retrieving network information to different devices. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated requesting network information to different devices into the system of Gile because it would have allowed efficient ways of accessing diverse networks information.

B. The Stated Ground For Rejection

Regarding section B, Applicant did not argue anything; instead Applicant just restated the ground for rejection.

C. The February 14, 2003 Response to Applicant's Arguments Eloquentlly Evidences the Improper Treatment Of Applicant's Claims.

"The key question in an obviousness inquiry is whether there is a suggestion in the record art of the desirability, and thus the obviousness, of modifying a prior art reference or combining prior references to form the claimed invention." (See brief, page 5). "It is preposterous to suggest that Gile's bare disclosure of modifiability would lead a

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person of ordinary skill in the art directly to the particular reference on which the Examiner is relying to fill in the missing pieces of Gile and form the claimed invention. The reliance of that proposition clearly shows impermissible hindsight use of Applicant's disclosure as a roadmap for reconstruction of the invention." (See brief, page 6)

In reply to argument in group C, applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In this case, the examiner has shown the missing piece which is "requesting network information to different devices", Gile's suggestion and Gardell's motivation (see examiner's answer in group A and rejection for claim 1 above). Thus, the examiner has established in combination of Gile and Gardell references, a prima facie case of unpatentability of claimed invention.

D. The Examiner's Modification of Gile is Improper (See brief, pages 7-8)

In reply to argument in group D, applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The examiner stated as above that Gile although does not explicitly disclose requesting network information to different devices, Gile suggests that the invention is not limited to one device receiving data across the Internet (col. 5, line 65 – col. 6, line 5), and that various changes and modifications could be made without departing from the invention. In the same field of endeavor, Gardell foresees that requesting network information from Internet to one device is not flexible and inefficient. To solve this problem, therefore, Gardell provides Internet users to access network information using a variety of devices. An artisan working with Gile would be motivated to search for downloading or retrieving network information to different devices. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Gile and Gardell to include providing internet users to access network information form a variety of devices. (Please see additional reasons to combine references of Gile and Gardell in response to argument in groups A)

E. Gardell Does Not Suggest Modifying Gile to Form the Claimed Invention

In reply to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, the Examiner has already pointed out Gile's suggestions such that the invention is not limited to one device receiving data across the Internet (col. 5, line 65 – col. 6, line 5), and that various changes and modifications could be made without departing from the invention. Gardell's system discloses motivation to provide internet users accessing network information from different devices is to allow more flexible ways of accessing networks, particular the Web (col. 1, lines 14-57). From Gile's suggestions and Gardell's motivation, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Gile and Gardell to provide a system for internet users accessing network information from different devices. (Please see additional reasons to combine references of Gile and Gardell in response to argument in groups A)

F. The Benefit Of The Invention Does Not Suggest Modifying Gile To Form It.

“If the prior art does not contain even a suggestion of the specific modifications that are needed to be made to the teachings of the prior art to yield the claimed invention, then a rejection on the grounds of obviousness based solely on the advantages provided by that claimed invention is an improper use of hindsight. See, e.g., *In re Fritch*, 972 F.2d 1260,1266.” (See brief, page 11)

In reply to argument in the group F, applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Again, “improper hindsight reasoning” argument has been addressed in group C, so please see examiner's answer in group C.

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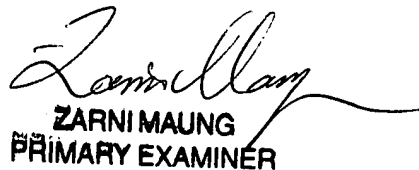
For the above reasons, it is respectfully submitted that the rejections should be sustained.

Conferee:

Respectfully Submitted,



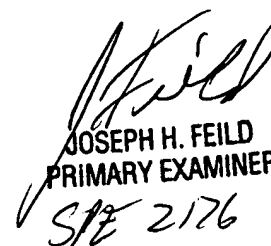
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